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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,778	08/01/2003	Christopher J. Terrels	0156-P02889US01	3091

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DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
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PHILADELPHIA, PA 19103-2307

EXAMINER

MACARTHUR, VICTOR L

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/632,778

Applicant(s)

TERRELS ET AL.

Examiner

Victor MacArthur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 15-22 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/7/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Species I, as shown in figure 2, in the reply filed on 2/8/2005 is acknowledged. The traversal is on the grounds that (1) applicants are entitled to a reasonable number of species in a single application; (2) there is no serious burden to search; (3) the examiner has failed to identify separate classification in the art; and (4) claim 11 is generic.

This is not persuasive as follows:

1. There is no "entitlement" to any particular number of patentably distinct species. An election requirement is proper with as little as two patentably distinct species. See MPEP 808.01(a). With respect to the identified species, it is noted that the applicant does not admit that these species are not patentably distinct (i.e. obvious variants of one another).
2. The applicant has failed to submit any evidence that there is no serious burden present. There is a clear and serious burden on the examiner to have to search for all of the features of the non-elected embodiment, consider and apply any prior art found, and then consider and respond to any arguments submitted by applicants relating thereto. Applicants have not indicated how this otherwise would not be the case.
3. The applicant's attention is directed to MPEP 809.02(a), which details the proper format to be used when requiring election between patentably distinct species. MPEP 817 clearly indicates that the statement in MPEP 809.02-809.02(d) is adequate indication of the form of the letter when election of species is required. Finally,

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MPEP 808.01(a) indicates that there is no need to show a separate status in the art or separate classification.

4. The applicant should note MPEP 806.04(d) for the definition of a “generic” claim.

Specifically, claim 11 requires a railing end configured to engage the rectangular shell and that the frame provides vertical support for the railing end on the cylindrical core. This is clearly shown in Fig.16 and there is no comparable structure found in the elected embodiment of Fig.2 (or Fig.3 for that matter). Apparently, the Applicant may be taking an extremely broad interpretation as to what constitutes “configured to engage the rectangular shell”. Be that as it may, claim 11 does not become “generic”. It is merely “broad” in scope. In view of the Applicant’s comments, the Examiner will interpret the “configured” recitation to be inclusive of either direct or indirect engagement. In other words, claim 11 does not actually require that railing end to contact the rectangular shell. This interpretation will apply to all other occurrences of “engaged” unless otherwise specifically limited.

The requirement is still deemed proper and is therefore made FINAL.

Claims 12-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on 2/8/2005.

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Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Proper antecedent basis should be provided for the following claim limitations:

- “cylindrical core” (line 1 of claim 1). The Examiner suggests amending the specification to refer to element (36) as the “cylindrical core” throughout to overcome this rejection.

Claim Objections

Claims 1 and 7 are objected to because of the following informalities:

- The phrase “the shell core” (line 7 of claim 1) lacks proper antecedent basis and should be replaced with “cylindrical core” for consistent claim terminology.
- The limitation “the hole” (line 2 of claim 7) lacks proper antecedent basis and should be replaced with --a hole--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5, 6, 11, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Ward (U.S. Patent 6,305,670).

Claim 1. Ward discloses (fig.2) a post and railing assembly comprising: a cylindrical core (26); a rectangular frame (30) configured for securing around the core; a rectangular shell (14) having an inner surface and an outer surface, said inner surface being configured for engagement (where the inner surface of 14 meets 30) with the rectangular frame; a railing (10) comprising a railing end (end of 10 as seen in fig.1) configured for coupling (via 18) with the outer (top portion of outer surface) surface of the rectangular shell; and a bracket (18) on the outer surface of the shell, said bracket forming a socket (hollow portion of 18) adapted to receive (at its top most portion) said railing end to secure said railing to the cylindrical core through the shell.

Claim 5. Ward discloses that bracket comprises a cylindrical hole (central hole of 18) that extends through the bracket, said hole being **adapted** (in that it is plastic and as such can be easily tapped for fasteners) to receive a bracket fastener that extends through the hole and the shell and into said frame to secure the bracket on the cylindrical core against the outer face of the shell (emphasis added). Note that the limitation “adapted to receive” does not necessarily require positive reception.

Claim 6. The bracket fastener (e.g. any fastener capable of performing as functionally claimed in claim 5) can be chosen such that it is configured (e.g. being long) to interconnect the frame, shell and bracket with said core. Note that the bracket fastener is initially recited in claim

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5 as a functional element rather than positively recited. Accordingly, claim 6 is not taken in combination.

Claim 11. Ward discloses (fig.2) a post and railing assembly comprising a cylindrical core (26); a rectangular frame (30) configured for securing around the core; a rectangular shell (14) having an inner surface and an outer surface, said inner surface being configured for engagement (where inner surface of 14 meets 30) with the rectangular frame; and a railing (10) comprising a railing end (end of 10 as seen in figure 1) configured for engaging (via 18) the rectangular shell, said frame providing vertical support (as seen in figure 2) for said railing end on said cylindrical core.

Claim 21. Ward discloses (fig.2) a post and railing assembly comprising a cylindrical core (26); a frame (30) configured for securing around the core, said frame comprising a tubular center section (42) and a plurality of support fins (fins connecting 42 to 36) extending radially outwardly from the tubular center section; a rectangular shell (14) having an inner surface and an outer surface, said inner surface being configured for engagement (wherein inner surface of 14 contacts 30) with the support fins on the rectangular frame; a railing (10) comprising a railing end (end of 10 as seen in fig. 1) configured for coupling with the outer surface (top outer surface of 10) of the rectangular shell; and a bracket (18) on the outer surface of the shell, said bracket forming a socket (inner socket portion of 18) adapted to receive said railing end (at top of inner socket portion of 18) to secure said railing to the shell core through the shell.

Claim 22. Ward discloses a plurality of corner flanges (corners of 30) extending outwardly from the support fins, said corner flanges being configured to engage the inner surface of the rectangular shell (prior to assembly). Note that the limitation “configured to engage” does

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not require positive engagement and that the limitation "engagement" does not require direct contact.

Claims 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Erwin (U.S. Patent 6,471,192).

Claim 15. Erwin discloses (fig.1) a bracket (10) for coupling a railing member to a supporting structure, said bracket comprising a socket (inner portion of 10) adapted to receive the end of the railing member and having a plurality of resilient flexible spring sheets (54) that are biased inwardly in the socket, said spring sheets being configured to impart inward pressure on the railing end when the railing is inserted in the socket to secure the railing end in the socket.

Claim 16. Erwin discloses a rear face (rear face of 10) that forms a notch (between 74 and 76) adapted to conform to a corner on a supporting structure.

Claim 17. Erwin discloses a curved rear face (curved rear face of 10) adapted to conform to a curved surface on a supporting structure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ward (U.S. Patent 6,305,670) in view of Kupiec (U.S. Patent 5,335,471).

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Claim 2. Ward discloses that the frame comprises two frame halves (left half of 30 and right half of 30) each having a semicircular inner face (left and right inner faces of 30), a generally rectangular outer face (left and right outer faces of 30), and one or more frame fasteners (38). Ward discloses that the frame halves are homogenous with one another in a one-piece construction rather than being separate pieces held together by frame fasteners. Kupiec teaches (figs.2 and 5) separate frame halves (14, 15) that are held together by frame fasteners (27) in a clamped arrangement around a core (11), the frame halves having semicircular inner faces adjoining one another in the clamped arrangement to form a cylindrical surface that frictionally engages the core, the frame halves having rectangular outer faces (outer faces of 14 and 15) forming a continuous outer skirt that engages an inner surface of a shell (29, 30, 31, 32). Kupiec indicates (col.2, ll.24-35) that such construction is durable, reliable and economical. It has generally been recognized that the separation of elements, where removability would be desirable, is a design consideration within the skill of the art. In re Dulberg, 283 F.2d 522, 129 USPQ 348 (CCPA 1961). Accordingly, it would have been obvious to one of ordinary skill in the art to modify the Ward frame halves to be separable, as taught by Kupiec, to increase durability, reliability, economy, and removability; as such practice is a design consideration within the skill of the art.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward (U.S. Patent 6,305,670) in view of Erwin (U.S. Patent 6,471,192).

Claim 3. Ward discloses that the shell, frames and brackets are formed of plastic but does not expressly state what type of plastic. Erwin teaches (col.4, ll.65-67) that rigid polyvinyl

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chloride (PVC) is preferable for railing components. One of ordinary skill in the art at the time the invention was made would have known that PVC is relatively low in cost, light-weight and durable. It has generally been recognized that selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to use PVC material, as taught by Erwin, to construct the plastic shell, frames and brackets of Ward, since PVC is preferable due to its low cost, light weight and durability.

Claim 4. Ward does not disclose spring sheets. Erwin teaches (fig.1) a bracket (10) comprising a plurality of resilient flexible spring sheets (54, 59) that are useful for allowing trapped moisture to escape from between the bracket and a rail (col.3, ll.39-42). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the Ward bracket to have spring sheets as taught by Erwin for the purpose of allowing moisture to escape from between the Ward bracket and rail. Note that the Erwin spring sheets are biased inwardly and configured to impart inward pressure on a railing end when the railing is inserted in the socket.

Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward (U.S. Patent 6,305,670) in view of Denman (U.S. Patent 5,827,029).

Claim 7. Ward discloses a hole (hole receiving 20) in the bracket having fasteners (20). Ward does not disclose covers for the hole. Denman teaches (fig.1) a generally cylindrical cover (20) configured for insertion into a hole (30) and having a resiliently flexible side wall (38) and

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an end wall (21), said side wall having a diameter when separated from the hole that is slightly larger than the diameter of the hole and a longitudinal slot (44) extending through the side wall of the cover, said side wall further being inwardly flexible to permit the cover to be inserted into the hole to enclose a fastener (10), said cover being inserted into the hole in a compressed condition in which the side wall is biased outwardly into frictional engagement with the interior wall of the hole. Denman states that such covers should be used with fasteners to prevent a small child from unscrewing the fasteners. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the Ward hole to use a cover, as taught by Denman, for the purpose of preventing a small child from unscrewing the Ward fasteners.

Claim 8. Ward as modified by Denman, suggests that the bracket (Ward) has an exterior contour, and the end wall of the cover (Denman) has an exterior face that conforms to the exterior contour of the brackets surrounding the hole (in that they are both circular).

Claim 9. Denman teaches that a hole should comprise an interior wall (interior of 33) and a tongue projection (32) extending along the interior wall, said tongue projection configured to mate with said longitudinal slot when the cover is inserted in the hole to limit rotational displacement (via friction) of the cover relative to the interior wall of the hole.

Claim 10. Denman teaches that the hole (30) comprises an interior wall (interior wall of 30) and an aperture (33) extending through the interior wall, said cover comprising a resilient flexible spring tab (38) having a tapered face (face of 38) that slidably engages the interior wall of the hole as the cover is inserted into the hole, said spring tab being configured to flex inwardly in a biased condition during insertion into the hole and snap outwardly when the spring tab is aligned with the aperture in the interior wall of the hole.

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Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erwin (U.S. Patent 6,471,192) in view of Denman (U.S. Patent 5,827,029).

Claim 18. Erwin discloses (fig.1) a bracket (10) for coupling a railing member to a post structure, said bracket comprising a socket (inner socket portion of 10) adapted to receive the end of a railing member and at least one hole (71, 73, 75, 77) for receiving a bracket fastener (col.4, ll.1-5) configured to extend through the hole to connect a bracket to a post structure. Erwin does not disclose covers for the holes. Denman teaches (fig.1) a generally cylindrical cover 20) adapted to be inserted in a hole (30) and having a resiliently flexible side wall (38) and an end wall (21), said side wall having a diameter when separated from the hole that is slightly larger than the diameter of the hole and a longitudinal slot (44) extending though the side wall, said side wall further being inwardly flexible to permit the cover to be inserted into the hole to enclose a fastener (10), said cover being inserted into the hole in a compressed condition in which the side wall is biased outwardly into frictional engagement with the interior wall of the hole. Denman states that such covers should be used with fasteners to prevent a small child from unscrewing the fasteners. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the Erwin bracket to use a cover, as taught by Denman, for the purpose of preventing a small child from unscrewing the Erwin fasteners.

Claim 19. Erwin as modified by Denman above suggests that the bracket (Erwin) has a curved exterior contour surrounding said hole (Erwin, curved exterior contour surrounding 71, 73, 75, 77), and the end wall (Denman, 21) of the cover has an exterior face (face of 21) with a curvature that conforms to the curved exterior contour of the bracket (in that they are both circular) .

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Claim 20. Denman teaches that the hole should comprise an interior wall (34) and a tongue projection (32) extending along the interior wall, said longitudinal slot configured to mate with said tongue projection when the cover is inserted in the hole to limit (via friction) rotational displacement of the cover relative to the interior wall of the hole.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Referring to post and railing assemblies and brackets thereof:

Bright U.S. Patent 3,921,960

Wylie U.S. Patent 4,958,807

Platt U.S. Patent 6,141,928

Pettit U.S. Patent 6,213,452

Elsasser U.S. Patent 6,467,756

Erwin U.S. Patent 6,557,831

Lapp U.S. Patent 6,643,982

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (703) 305-5701.

The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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April 1, 2005

Daniel P Stodola

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